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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,236	02/15/2000	Swain W. Porter	112076-138321	7611

25943 7590 03/21/2007
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EXAMINER

SHINGLES, KRISTIE D

ART UNIT	PAPER NUMBER
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2141

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/504,236

Applicant(s)

PORTER, SWAIN W.

Examiner

Kristie Shingles

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 12-20, 24, 26-29, 31-38, 41-46 and 48-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12-20, 24, 26-29, 31-38, 41-46 and 48-71 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendments

Claims 7-11, 21-23, 25, 30, 39, 40 and 47 are cancelled.

Claims 33, 35, 41, 50, 52, 62 and 67 are amended.

Claims 1-6, 12-20, 24, 26-29, 31-38, 41-46 and 48-71 are pending.

Response to Arguments

I. Applicant's arguments (see Remarks pages 19-20), filed 1/5/2007, with respect to claims 13, 24, 26, 31, 32, 42, 43, 48, 49, 58 and 61 have been fully considered and are persuasive. Therefore, the 35 U.S.C.103(a) rejection under *Pennell et al* (US 6,874,023) in view of *Winbladh* (US 6,205,330) and *Waskiewicz* (US 5,822,526) in further view of *Bunney* (US 6,487,584) of the above claims has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of *Hall* (US 5,930,479).

II. Applicant's arguments, filed 1/5/2007, regarding claims 1 and 33 have been fully considered but they are not persuasive.

A. Regarding Claim 1: Applicant argues that cited prior art of record, *Winbladh* (US 6,205,330) and *Waskiewicz* (US 5,822,526), fail to teach the simultaneous provision of first and second email addresses that are "separate and distinct".

Examiner respectfully disagrees. Firstly, "the simultaneous provision" of the first and second email addresses is not taught or supported in Applicant's disclosure. However,

Art Unit: 2141

Winbladh teaches that a user is sent correspondence including the registered email address and alias addresses for the registered user (*col.4 lines 54-57, col.8 lines 46-50*), which indicates that the alias addresses are provided/generated for the user at the same time that primary email address is provided/generated. Alias email addresses are separate and distinct from primary email addresses, because they include different user identification that—although referring to the same user—creates email addresses distinct to the primary email address. Furthermore *Waskiewicz* teaches that when a new mailbox is created for a user, a proxy address is also created, wherein there may exist multiple proxy addresses for one email address, as well as proxy addresses for distinct address types (*col.3 lines 4-20, col.5 lines 4-23, col.6 lines 20-44, col.7 line 57-col.8 line 5, col.8 line 6-col.9 line 24*). Applicant citation of “separate and distinct” in the claim does not specify the exact distinction or the degree of separateness between the email addresses. *Waskiewicz* teachings and illustration (*Figure 3, col.6 lines 31-34*) along with *Pennelle et al* (*col.1 lines 12-15 and 56-61, col.3 lines 24-34*), specifically, fulfills the functionality of the claim language as supported by Applicant’s disclosure, wherein the user identifiers of the email addresses are “separate and distinct” from one another and wherein the email addresses comprise the same email service provider. Thus, in light of considering the claim in its broadest interpretation, the implementation of proxy/alias addresses in the prior art still qualifies as distinct and separate addresses associated with a specific user. Applicant’s arguments are therefore unpersuasive and the rejection under the cited prior art of record is maintained.

Art Unit: 2141

- B. Regarding Claim 1: Applicant argues that there is no motivation to combine the teachings of *Pennell et al* (US 6,874,023) in view of *Winbladhi* (US 6,205,330) in further view of *Waskiewicz* (US 5,822,526).**

Examiner respectfully disagrees. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, combining the teachings of *Pennell et al* and *Winbladhi* with *Waskiewicz* to generate first and second (multiple) email addresses for registered users, enables users to have and use additional email addresses for communicating with particular websites or other users from aliased identities which ensures the user's privacy and allows the user to more convenience in managing electronic/Internet communications. Applicant's arguments are therefore unpersuasive and the rejection under the cited prior art of record is maintained.

- C. Regarding Claim 33: Applicant argues that the cited prior art of record, *Gabber et al* (US 6,591,291), fail to teach that sorting of the email messages based on intended versus unintended communication partners.**

Examiner respectfully disagrees. *Pennell et al* teach the employment and unemployment of email address associated with particular websites based on the user's preference (*col.3 line 61-col.4 line 43*)—thus the user is able to delete the email address and configure the email system based on preferred communication with particular websites. *Gabber et al* further teach employing alias addresses to filter unwanted email messages (*col.3 lines 20-34*). Thus it is evident from the selectivity of the email filtering and the email address

employment/unemployment that the systems of *Pennell et al* and *Gabber et al* enable sorting of email messages associated with the employed email addresses. Applicant's arguments are therefore unpersuasive and the rejection under the cited prior art of record is maintained.

- D. Regarding Claim 33:** Applicant argues that the motivation used to combine cited prior arts *Pennell et al* (US 6,874,023) and *Winbladh* (US 6,205,330) in further view of *Waskiewicz* (US 5,822,526) and *Gabber et al* (US 6,591,291) was based on hindsight reconstruction.

Examiner respectfully disagrees. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Regarding the combination of *Pennell et al*, *Winbladh* and *Waskiewicz* with *Gabber et al*, the motivation for organizing email messages according to the user's different email addresses and presenting the email messages of interest to the user is clearly evident in *Gabber et al* (col.2 lines 33-50) and in *Pennell et al* (col.1 lines 32-61); wherein both teach email control and management by virtue of employing unique email addresses and organizing messages in order to minimize unwanted/unintended email communication with the user. Applicant's arguments are therefore unpersuasive and the rejection under the cited prior art of record is maintained.

Allowable Subject Matter - Withdrawn

- III. Regarding Claims 14, 27 and 44:** The indicated allowability of claims 14, 27 and 44 is

Art Unit: 2141

withdrawn in view of the newly discovered reference(s) to *Hall* (US 5,930,479). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

IV. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

V. Claims 1-6, 15, 16, 20, 28, 29, 41, 45, 46, 56, 57, 59, 60, 62, 64-67 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pennell et al* (US 6,874,023) in view of *Winblad* (US 6,205,330) in further view of *Waskiewicz* (US 5,822,526).

a. Per claim 1, *Pennell et al* teach a method comprising:

- a user computer providing a first email address received from an email service provider for use to register a user of the user computer with a first web site (*col.1 lines 53-62*); and
- the user computer providing a second email address received from the email service provider, separate and distinct from the first email address, for use to register said user with a second web site (*col.1 lines 12-15 and 56-61, col.3 lines 24-34*).

Although *Pennell et al* teach an email management service that generates a new email address whenever needed or requested by the user (*col.3 lines 1-12 and 35-42, col.4 lines 15-17*), *Pennell et al* fail to explicitly teach wherein the first and second email addresses were simultaneously provided to the user computer by the email service provider in advance of providing the first and second email addresses to the first and second web sites by the user computer. However, *Winblad* teaches that upon successfully obtaining an email account, a user

Art Unit: 2141

is sent correspondence including the registered email address and alias addresses for the registered user (*col.4 lines 54-57, col.8 lines 46-50*). Furthermore, *Waskiewicz* teaches that when a new mailbox is created for a user, a proxy address is also created, wherein there may exist multiple proxy addresses for one email address (*col.3 lines 4-20, col.5 lines 4-23, col.6 lines 20-44*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Pennell et al* and *Winbladh* with *Waskiewicz* for the purpose of generating first and second (multiple) email addresses to registered users, in order to provide the users with additional email addresses usable for communicating with particular websites or other users from aliased identities which ensures the user's privacy and minimizes unsolicited email communications with the user.

b. **Claims 28, 41, 45, 56, 59, 62 and 67** contain limitations that are substantially equivalent to claim 1 and are therefore rejected under the same basis.

c. **Per claim 2**, *Pennell et al* and *Winbladh* with *Waskiewicz* teach the method of claim 1, *Waskiewicz* further teaches wherein the first email address comprises a first user identifier, and the second email address comprises a second user identifier, separate and distinct from said first user identifier (*col.3 lines 4-20, col.5 lines 4-23, col.6 lines 20-44; Winbladh: col.4 lines 54-57, col.8 lines 46-50*).

d. **Claim 4** is substantially similar to claim 2 and is therefore rejected under the same basis.

e. **Per claim 3**, *Pennell et al* and *Winbladh* with *Waskiewicz* teach the method of claim 1, *Pennell et al* further teach wherein the first email address comprises an address of the

Art Unit: 2141

email service provider, and the second email address comprises the address of the same email service provider (*col.3 lines 1-12 and 35-42; Winbladh: col.4 lines 54-57, col.8 lines 46-50*).

f. **Per claim 5**, *Pennell et al* and *Winbladh* with *Waskiewicz* teach the method of claim 1, *Winbladh* further teaches wherein said providing of the first and second email addresses by the user computer comprises selecting by said first and second email address from a plurality of distinct email addresses simultaneously provided by said email service provider to said user computer (*col.4 lines 54-57, col.8 lines 46-50; Waskiewicz: col.3 lines 4-20, col.5 lines 4-23, col.6 lines 20-44*).

g. **Claim 29** is substantially similar to claim 5 and is therefore rejected under the same basis.

h. **Per claim 6**, *Winbladh* teach the method of claim 5, wherein the method further comprises the user computer obtaining the distinct email addresses from the email service provider in advance of the selection (*col.4 lines 54-57, col.8 lines 46-50; Waskiewicz: col.3 lines 4-20, col.5 lines 4-23, col.6 lines 20-44*).

i. **Per claim 15**, *Pennell et al* and *Winbladh* with *Waskiewicz* teach the method of claim 1, *Pennell et al* further teach wherein the method further comprises: receiving emails addresses to said first and second email; organizing said received emails based at least in part on whether the emails are addressed to the first of the second email address (*col.4 lines 15-43*).

j. **Per claim 16**, *Pennell et al* teach the method of claim 15, wherein said organizing of said received emails is at least further based on whether said received emails addressed to said first or second email address were sent respectively by said first or second web site or not (*Figure 6, col.3 lines 53-65, col.4 lines 35-43*).

Art Unit: 2141

k. **Claims 64, 65, 69 and 70** are substantially similar to claims 15 and 16 and are therefore rejected under the same basis.

l. **Per claim 20**, *Pennell et al* and *Winbladh with Waskiewicz* teach the method of claim 1, *Pennell et al* further teach wherein the web site is a content provider, a service provider and an access provider (*col.1 lines 17-31*).

m. **Per claim 46**, *Pennell et al* and *Winbladh with Waskiewicz* teach the apparatus of claim 45, *Winbladh* further teach wherein the programming instructions (when executed) enable the apparatus to provide a plurality of distinct email addresses to the electronic device used by the user in advance of the first and second email addresses' initial selection for usage, for the electronic device to select said first and second separate and distinct email addresses (*col.4 lines 54-57, col.8 lines 46-50*).

n. **Claims 57 and 60** are substantially similar to claims 5 and 46 and are therefore rejected under the same basis.

o. **Per claim 66**, *Pennell et al* and *Winbladh with Waskiewicz* teach the method of claim 62, *Waskiewicz* further teach the method further comprising: generating and sending a request to the email service provider to return a set of email addresses including a plurality of distinct email addresses (*col.5 lines 4-23, col.6 lines 20-44; Winbladh: col.4 lines 54-57, col.8 lines 46-50*).

p. **Claim 71** is substantially similar to claim 66 and is therefore rejected under the same basis.

Art Unit: 2141

VI. Claims 13, 14, 24, 26, 27, 31, 32, 42-44, 48, 49, 58 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pennell et al* (US 6,874,023) in view of *Winbladh* (US 6,205,330) and *Waskiewicz* (US 5,822,526) in further view of *Hall* (US 5,930,479).

q. Per claim 24, *Pennell et al* teach a method comprising:

- an electronic device requesting and receiving for a user, a first email address from an email service provider at a first point in time subsequent to the user subscribing for email service with the email service provider (*col.1 lines 53-62*);
- the electronic device employing the received first email address to facilitate communication between the user and a first communication partner or group of communication partners (*col.1 lines 12-15 and 56-61, col.3 lines 24-34*);
- the electronic device requesting and receiving for the user, a second email address, separate and distinct from said first email address, from the email service provider at a second point in time subsequent to the user subscribing for email service with the email service provider, the second point in time being a later point in time than the first point in time (*col.1 lines 53-62, col.3 lines 1-12*); and
- the electronic device employing the received second email address to facilitate communication between the user and a second communication partner or group of communication partners (*col.3 lines 13-65*).

Winbladh teaches that upon successfully obtaining an email account, a user is sent correspondence including the registered email address and alias addresses for the registered user (*col.4 lines 54-57, col.8 lines 46-50*). Furthermore, *Waskiewicz* teaches that when a new mailbox is created for a user, a proxy address is also created, wherein there may exist multiple proxy addresses for one email address (*col.3 lines 4-20, col.5 lines 4-23, col.6 lines 20-44*). Yet *Pennell et al*, *Winbladh* and *Waskiewicz* fail to explicitly teach the electronic device, prior to the first communication partner or group of communication partners initiating a communication with the user, notifying the email service provider of said employment of the first email address to facilitate communication with the first communication partner or group of communication partners and the electronic device, prior to the second communication partner or group of

Art Unit: 2141

communication partners initiating a communication with the user, notifying the email service provider of said employment of the second email address to facilitate communication with the second communication partner or group of communication partners.

However, *Hall* teaches that a user allocates a number of channelized addresses having differing channel identifiers for different correspondents, wherein a channel map associates each correspondent with the user selected channel and the channel identifiers are incorporated into the user's email address to create multiple email addresses associated with the user but used for different correspondents (*col.7 lines 53-67, col.10 lines 26-67, col.17 lines 7-54, col.20 lines 45-53*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Pennell et al*, *Winbladh* and *Waskiewicz* with *Hall* for the system to provide means for determining which channelized email address is associated with which correspondent—this allows for reliable categorization and filtering based on the different channel identifiers, providing a user with the means to specify a particular channel when corresponding with a specific website or user.

r. **Claims 13, 14, 26, 27, 31, 32, 42-44, 48, 49, 58 and 61** are substantially similar to claim 24 and are therefore rejected under the same basis.

VII. Claims 12, 17-19, 33-38, 50-55, 63 and 68-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pennell et al* (US 6,874,023) in view of *Winbladh* (US 6,205,330) and *Waskiewicz* (US 5,822,526) in further view of *Gabber et al* (US 6,591,291).

s. **Per claim 33**, *Pennell et al*, *Winbladh* and *Waskiewicz* teach a method comprising: an email service provider receiving emails addressed to a first and second email address of a user, the first and second email addresses being separate and distinct from each other having been provided by the email service provider to an electronic device of the user for

Art Unit: 2141

the electronic device to facilitate respective communication between the user and a first and a second intended communication partner (*Pennell et al*: col.3 lines 1-65; *Winbladh*: col.4 lines 54-57, col.8 lines 46-50; *Waskiewicz*: col.5 lines 4-23, col.6 lines 20-44).

Pennell et al further teach the email server provider organizing the received emails based on the distinct email addresses of users and allowing for the user to designate which are wanted or unwanted (*Figure 6*, col.3 lines 53-65, col.4 lines 35-43); yet *Pennell et al* and *Winbladh* with *Waskiewicz* fail to explicitly teach the email server provider organizing said received emails based at least in part on said first and second email addresses of the user, and respective intended versus unintended communication partners of said first and second email addresses of the user. However *Gabber et al* teach organizing and filtering of reply emails based the alias source address, wherein the alias source address depends on the destination address in order to identify which alias addresses are reject alias source addresses—if the reply email contains a reject alias source address then the reply message is deleted (*Abstract*, col.3 lines 20-44, col.8 lines 5-18 and 27-66). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Pennell et al*, *Winbladh* and *Waskiewicz* with *Gabber et al* for the purpose of organizing email messages according to the user's different email addresses and presenting the email messages of interest to the user, wherein the user can bypass reading messages from parties of no interest. This also provides users an effective way to determine where junk email purveyors obtained the user's alias source address.

t. **Claims 17, 35, 36, 50, 52, 53 and 69** contain limitations that are substantially equivalent to claim 33 are therefore rejected under the same basis.

u. **Per claim 34**, *Pennell et al*, *Winbladh* and *Waskiewicz* with *Gabber et al* teach the method of claim 33, *Pennell et al* wherein said organizing of said received emails is at least further based on whether said received emails addressed to said first or second email address were sent respectively by said first or second web site or not (*Figure 6, col.3 lines 53-65, col.4 lines 35-43; Gabber et al: col.8 lines 56-66*).

v. **Claim 51 and 70** are substantially equivalent to claim 34 and are therefore rejected under the same basis.

w. **Per claim 37**, *Pennell et al*, *Winbladh* and *Waskiewicz* with *Gabber et al* teach the method of claim 36, *Gabber et al* further teach wherein said deletion is performed in response to user instruction (*col.8 lines 35-37*).

x. **Claims 18 and 54** are substantially similar to claim 37 and are therefore rejected under the same basis.

y. **Per claim 38**, *Gabber et al* teach the method of claim 37, wherein the method further comprises providing the user with an end user interface feature to provide said deletion instruction with a single press of a key or control button (*col.3 lines 26-34, col.8 lines 56-66*).

z. **Claims 19 and 55** are substantially similar to claim 38 and are therefore rejected under the same basis.

aa. **Per claim 63**, *Pennell et al*, *Winbladh* and *Waskiewicz* with *Gabber et al* teach the method of claim 62, *Gabber et al* further teach the method further comprising: sending information to the email service provider relating the first email address to the first intended communication partner or partners and the second email address to the second intended communication partner or partners (*col.3 lines 35-41, col.8 lines 27-50*).

Art Unit: 2141

bb. **Claims 12 and 68** are substantially similar to claim 63 and are therefore rejected under the same basis.

Conclusion

VIII. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Beyda et al (7,120,927), Millard (6,643,685), Agraharam et al (5,987,508), Arnold et al (6,965,918), Hickman et al (2005/0188046), Helfman et al (6,396,513), Huang et al (5,758,354), Miller et al (6,615,241), Megiddo (6,725,269), Chung et al (7,136,901).

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharra can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER